

Appln No. 09/917,192
Amdt date June 21, 2005
Reply to Office action of 12/22/2004

REMARKS/ARGUMENTS

In response to the Office action of December 22, 2004 and to the Examiner Interview of June 20, 2005, Applicant submits the above amendments and the following remarks. Claim 33 is added. Claims 1-14 and 23-33 are pending in the application. Applicant submits a Request for Continued Examination herewith and requests that the Examiner carefully review the amendments and arguments presented herewith. Applicant notes with appreciation that the Examiner indicated in a telephone interview on June 6, 2005 that he would contact the undersigned telephonically to discuss the claims if any issues of patentability remain.

Independent claim 33 is currently added, and is directed to a single piece of plastic having a substantially rigid portion and a substantially elastic portion, the substantially rigid portion having long glass fibers within the plastic as reinforcement, and the substantially elastic portion substantially free of long glass fibers. Applicant respectfully submits that claim 33 is definite and is not taught or suggested by any of the cited references, alone or in motivated combination. Applicant therefore respectfully requests that claim 33 be allowed.

On page 2 of the Office action, claims 1-14 and 23-31 are rejected under 35 U.S.C. 112, second paragraph as indefinite. The Examiner contends that the phraseology "wherein the substantially rigid portion and the substantially plastic portion are of the same plastic" is not understood by the Examiner, and that he does not understand how one portion of the

Appln No. 09/917,192
Amdt date June 21, 2005
Reply to Office action of 12/22/2004

plastic can contain long fibers and the other portion of the plastic be free of long fibers. Applicant assumes that the Examiner is referring to the phrase "wherein the substantially rigid portion and the substantially elastic portion are of the same plastic" in Applicant's claim 1. Applicant respectfully traverses this rejection.

In the interview conducted with Examiner Redman on September 17, 2004, it is believed that the Examiner acknowledged that the phrase "are of the same plastic" was understood without further elaboration or amendment, and that the same plastic may have two portions formed in one piece and of the same plastic, one portion reinforced by long glass fibers and the other portion substantially free of long glass fibers, and that these limitations did not appear to be present in the references discussed in the May 17, 2004 Office action. See Response to Office action mailed September 17, 2004. In further support of how a portion of plastic can be reinforced with long glass fibers, Applicant submits a Wikipedia definition of glass-reinforced plastic in an IDS filed herewith as evidence that reinforcement with glass fibers of a portion of plastic is well-known in the art. Applicant respectfully requests reconsideration of the 112 rejection and allowance of claims 1-14 and 23-31.

The Examiner also indicates that the phrase "staple glass fibers" is not understood. Applicant respectfully traverses this rejection and submits that "staple glass fibers" is readily understood in the art. Evidence of this understanding is outlined in the encyclopedia entry for "Fiber" in Microsoft®

Appln No. 09/917,192
Amdt date June 21, 2005
Reply to Office action of 12/22/2004

Encarta® Online Encyclopedia 2005, attached in an Information Disclosure Statement, filed herewith. That entry discloses the following knowledge of those skilled in the art, "There are two main forms of glass fibers: continuous and staple. *Continuous* glass fiber, which is made by drawing molten glass into threads, is used in textile materials. The use of air, steam, or gas to disrupt the flow of the molten glass stream produces *staple* fibers." Applicant therefore respectfully submits that claim 10 is not indefinite and requests its reconsideration and allowance.

On page 2 of the Office action, the Examiner has rejected claims 1-10, 14, and 23-32 as anticipated by Whitehead, et al. Applicant respectfully traverses this rejection.

Applicant first points out that Whitehead contains no teaching or suggestion of "a substantially rigid portion of long glass fiber reinforced plastic," as recited in Applicant's independent claims. The Examiner states that the door trim panel 34 is "formed of hard plastic, polypropylene, *i.e. these plastics have long fibers/staple glass fibers*, column 3, line 48)." The Examiner is correct that Whitehead discloses that the door trim panel 34 may be formed of hard plastic or polypropylene. However, it does not disclose that such hard plastic or polypropylene contains long glass fibers or staple glass fibers. If the Examiner contends that either hard plastic or polypropylene necessarily include long glass fibers, Applicant respectfully disagrees. Applicant submits in an Information Disclosure Statement herewith an Answers.com printout containing several definitions of *plastic*, including a

Appln No. 09/917,192
Amdt date June 21, 2005
Reply to Office action of 12/22/2004

Wikipedia encyclopedia entry (page 11 of the Answers.com printout) discussing both polypropylene as a *plastic* and glass-reinforced plastic, as a plastic *composite* containing plastic and a glass fiber structure. Although Applicant has supplied these references for convenience, it is submitted that these terms are well-known in the art and one of ordinary skill would not need to review these references to understand the plain meaning of Applicant's independent claims.

Applicant further submits that Whitehead does not describe a substantially rigid portion of long glass fiber reinforced plastic formed in one piece and of the same plastic as the carrier 20. Moreover, the disclosed method of forming the carrier 20 out of expanded polypropylene includes fusing beads of plastics together by mechanical and thermoplastic bonding caused by steam, which is not suitable for formation of a substantially rigid portion of long glass fiber reinforced plastic in one piece, and of the same plastic as a substantially elastic portion of plastic substantially free of long glass fibers. Because Whitehead does not describe any element having long glass fiber reinforced plastic, Applicant respectfully submits that claims 1-10, 14, and 23-32 are novel over Whitehead and requests that they be allowed.

On page 4 of the Office action, the Examiner rejects claims 11-13 under 35 U.S.C. 103(a) as obvious over Whitehead in view of newly-cited reference Eckhardt et al. Applicant respectfully submits that Eckhardt fails to cure Whitehead's deficiencies. Like Whitehead, Eckhardt teaches that the door trim panel 20 should be made of plastic. Col. 3, lns. 7-17. The Examiner

Appln No. 09/917,192
Amdt date June 21, 2005
Reply to Office action of 12/22/2004

points out that a separate and unrelated element (drum 30) that is a "part of the window lift mechanism" is made of glass reinforced plastic. Col. 3, lns. 26-27. Although Eckhardt states that the drum can be made of "NYLON(R) including glass fibers," Eckhardt does not teach that a portion of the door trim panel should be modified to include long glass reinforced plastic, and be formed in one piece and of the same plastic as the carrier 20 of Whitehead.

In fact, Eckhardt teaches away from Applicant's invention by stating that the door trim panel should be made of plastic (not specifying glass reinforcement) and that a glass-reinforced NYLON drum is formed as a completely separate element. Applicant therefore respectfully submits that the rejections to claims 7-17 be withdrawn.

On page 3 of the Office action, claims 1, 2, 4-10, 14, 23-25, and 27-32 are again rejected as unpatentable over *Seijirou* in light of *Seksaria*. In support of these rejections, the Examiner has repeated the contentions in the last two Office actions without addressing Applicant's arguments in response, stating that these arguments are "moot in view of the new ground of rejection." As they have not yet been addressed, Applicant respectfully repeats its earlier arguments regarding *Seksaria* and *Seijirou* as follows:

Seijirou relates to a door module system that allows easy adhesion of a door service hole covering 8 to a door main part 7 and a door trim and allow easy separation to correct any position gap in the original adhesion. *Seijirou*, Col. 1 line 48-Col. 2 line 4. To achieve this objective, a film-like sheet

Appln No. 09/917,192

Amdt date June 21, 2005

Reply to Office action of 12/22/2004

8 is strongly adhered to the door main part 7 through adhesives 6. The door trim 9 is then adhered to an outer periphery of the film-like sheet 8 and fixed to the door main part 7 by grommets. The film-like sheet is perforated in an area between the adhesives 6 on one side of the sheet and adhesives holding the film-like sheet to the door trim 9 on the other. If there is a location gap, therefore, the film-like sheet 8 can be torn along its perforation, separating the door main part 7 and the door trim 9 to allow for readjustment.

The Examiner states that a rigid portion of the "door module (8 and 9)" of *Seijirou* corresponds to the substantially rigid portion of long glass fiber reinforced plastic of Applicant's claims 1 and 23 and that the "weatherseal (6)" of *Seijirou* corresponds to the elastic portion. The Examiner has not pointed out which portion of the "door module (8 and 9)" he contends is the "rigid portion" corresponding to the substantially rigid portion in Applicant's claims. If the Examiner contends that the door trim 9 of *Seijirou* is the "rigid portion" of the module, Applicant respectfully submits that the door trim is not even in contact with what the Examiner calls the "weatherseal (6)," (actually adhesives 6) much less "formed in one piece" with the adhesives 6. Moreover, forming the door trim in one piece with the adhesives 6 would render *Seijirou* inoperative, as the objective of easy separation of the door trim 9 with the door main part 7 (which the adhesives 6 are strongly adhered to) would not be addressed.

Applicant will therefore assume that the Examiner believes that the service hole cover 8 of *Seijirou* corresponds to the

Appln No. 09/917,192

Amdt date June 21, 2005

Reply to Office action of 12/22/2004

substantially rigid portion in Applicant's claims. The service hole cover 8 is disclosed in *Seijirou* as a "film-like sheet" which "does not have rigidity and cannot hold a fixed configuration in itself." *Seijirou*, Col. 1 ln. 47-Col. 2 ln. 4. Likewise, the "weatherseal 6" that the Examiner contends corresponds to the substantially elastic portion of the same plastic as the substantially rigid portion are "adhesives 6 of a butyl system." *Seijirou*, Col. 1, lines 35-45. Neither of these elements appears to correspond to Applicant's claim 1.

Seksaria fails to cure this deficiency. The Examiner cites *Seksaria*, Col. 4, lines 35-36 as disclosing "a door assembly of fiber reinforced plastic." The Examiner is correct that this portion of *Seksaria* suggests a mat made of woven "fiber reinforced tapes." Applicant, however, submits that this passage fails to teach or suggests a *substantially rigid* portion of *long glass fiber reinforced plastic*. In fact, *Seksaria* discloses that whatever material is used for the woven mat should have portions that are "freely movable with respect to each other" so that the mat may be freely deformed through "bending, stretching and relative movement of the individual elements." Col. 4, lines 15-20, 35-36. This passage clearly does not teach the use of a substantially rigid portion of long glass fiber reinforced plastic.

Even if, however, *Seksaria* were to disclose a substantially rigid portion of long glass fiber reinforced plastic, the Examiner has not pointed out an appropriate motivation to combine the references. The mere fact that references can be combined or modified does not render the resultant combination

Appln No. 09/917,192
Amdt date June 21, 2005
Reply to Office action of 12/22/2004

obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). The Examiner's only argument for combining the references is an assertion not present in either reference: that fiber reinforced plastic is cheaper to manufacture, stronger and lighter than conventional plastic. *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970), states that the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute."

Moreover, there is no suggestion or motivation to make the proposed modification if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). *Seijirou* states that the service hole cover 8 is "film-like" and is to be torn along its perforation 11 and stay on the door main part 7 when the door trim 9 is removed from the door main part 7 after the grommet 95 holding them together is loosened. See Col. 3, lns 21-32. Applicant finds it difficult to believe that a substantially rigid portion of long glass fiber reinforced plastic would be more suitable than the film-like sheet for the flexible mounting and easy tearing along a perforation that *Seijirou* explains is the purpose of the invention. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959).

Appln No. 09/917,192
Amdt date June 21, 2005
Reply to Office action of 12/22/2004

Finally, even if 1) there were a motivation to combine the cited references, 2) the combination would not render the service hole cover of *Seijirou* unsatisfactory for its intended purpose, and 3) the adhesive of *Seijirou* were considered a substantially elastic portion of plastic substantially free of long glass fibers, the combined references would still not teach or suggest that these elements are formed in one piece and are of the same plastic.

Applicant cannot find in either of the cited references any teaching or suggestion that the substantially rigid portion and substantially elastic portion are of the same plastic. Moreover, Applicant cannot find and the Examiner has not pointed out any teaching or suggestion in the cited references that the substantially rigid portion of fiber reinforced plastic and the substantially elastic portion of plastic substantially free of long glass fibers are in one piece.

As discussed above, Applicant submits that the cited references do not teach or suggest a substantially rigid portion of long glass fiber reinforced plastic and a substantially elastic portion of plastic substantially free of long glass fibers, even in separate pieces. The Examiner no longer appears to assert that the limitation "formed in one piece" would be a *de facto* obvious engineering choice, and Applicant again submits that this limitation is not taught or suggested in the cited references.

Applicant additionally submits that the advantages of the one piece construction over a two piece construction fused or injection moulded together are outlined in the Substitute

Appln No. 09/917,192
Amdt date June 21, 2005
Reply to Office action of 12/22/2004


Specification. Namely, the prior art "integration of seals and other features is limited as is the elasticity of the integrated features due to the structure requirements of the carrier," and the prior art "door modules are produced from a short glass fiber plastic compound...[which is] expensive." *Substitute Specification*, p. 1, paragraph 4. Accordingly, by forming the substantially rigid and elastic portions in one piece from the same plastic, the door module "achieves integration" and "the cost...is reduced." *Substitute Specification*, p. 2, paragraph 1.

For the reasons discussed above, Applicant respectfully submits that: 1) neither *Seijirou* nor *Seksaria* teaches or suggests all of the limitations of claims 1 and 23; 2) there would be no motivation to combine the references and; 3) even if combined, the references would fail to teach or suggest all of the limitations of Applicant's independent claims. Applicant therefore respectfully requests that these rejections be withdrawn.

Appln No. 09/917,192
Amdt date June 21, 2005
Reply to Office action of 12/22/2004

In light of the above remarks, Applicant respectfully submits that all claims are in proper form for allowance, and requests that the Examiner's rejections be withdrawn. If the Examiner disagrees, Applicant requests that he kindly contact the undersigned to discuss any claims that he does not now consider allowable.

Respectfully submitted,
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